Office - Supreme Court, U. S.
FILED
SEP 5 1942
CHARLES ELMORE CROPLEY
CLERK

In The

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 377

RONNING MACHINERY COMPANY and
THE GALION IRON WORKS AND
MANUFACTURING COMPANY,
Petitioners and Appellants Below,

vs.

CATERPILLAR TRACTOR CO.,
Respondent and Appellee Below.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

HARKER H. HITTSON,
c/o The Jeffrey Mfg. Co.,
Columbus, Ohio,
Counsel for Petitioner.

INDEX.

	PAGE
Petition for Writ of Certiorari	1
Summary statement of the matter involved	2
Reasons relied on for the allowance of the writ	3
Brief in support of Petition for Writ of Certiorari	6
The opinions of courts below	6
Jurisdiction	6
Statement of the case	7
Specification of Errors	7
Argument (summary)	9
Complete Argument	15

Cases Cited.

Continental Paper Bag Co. v. Eastern, 210 U. S. 405	10
DeForest Radio v. General Elec. 283 U. S. 664	7
Ex parte Derby, 1884 C. D. 21	27
Diamond Rubber Co. v. Consolidated, 220 U. S. 428	14
Emery et al. v. Cavanagh, 17 Fed. 242	27
Galion v. Adams, 105 Fed. (2d) 943	3, 9, 10, 16
Galion v. Adams, 128 Fed. (2d) 411	3, 9, 15
Galion v. Beckwith, 25 Fed. Supp. 73	10, 18
Ide v. Trorlicht, 115 Fed. 137	27
James v. Campbell, 104 U. S. 356	27

Jockmus v. Gale, 295 Fed. 208 27

Loom Co. v. Higgins, 105 U. S. 580 14

Milcor Steel Co. v. Fuller, et al., U. S. Supp. Ct. No. 720, April 27, 1942 10

Myers et al. v. Austin-Western Road Mach. Co., 45 Fed. (2d) 751 ..... 13, 17, 20, 25

National Biscuit Co. v. Crown Baking Co., 105 Fed. (2d) 422 28

Remington v. National, 6 Fed. (2d) 585 27

Robinson on Patents, Sec. 360, p. 515 28

Ronning Machinery Co. v. Winsor, 76 Fed. (2d) 392 ..... 12, 17

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47 7

Smith & Griggs Mfg. Co. v. Sprague, 123 U. S. 249.... 28

Star Mfg. Co. v. Crescent Forge & Shovel Co., 179 Fed. 856 28

Walker on Patents, Deller Edition, p. 372 27

Westinghouse v. Formica, 266 U. S. 342 10

Williams Mfg. Co. v. United Shoe Machinery Corp., 53 U. S. P. Q. 478—U. S. Supp. Ct. No. 332, May 25, 1942 ..... 10, 13, 15

STATUTES CITED.

Judicial Code Sec. 240 (a) (28 U. S. C. 347) 6

R. S. 4886 (U. S. C. Title 35, Sec. 31) 4, 26

In The

Supreme Court of the United States

October Term, 1942.

No.

RONNING MACHINERY COMPANY and
THE GALION IRON WORKS AND
MANUFACTURING COMPANY,
Petitioners and Appellants Below,

vs.

CATERPILLAR TRACTOR CO.,
Respondent and Appellee Below.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable the Supreme Court of the United States:

Your petitioners respectfully show:

I.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

This action was originally filed and tried in the United States District Court, Southern District of Illinois, Northern Division, Honorable J. Leroy Adair, presiding, at Peoria, Illinois.

The action was brought by petitioner, Ronning Machinery Co., for infringement by respondent of four of its patents, numbered Reissue 19,846; 1,658,353; 1,660,050 and 1,883,403; and by petitioner, The Galion Iron Works and Manufacturing Company (hereafter called Galion), for infringement by respondent of two of its patents, being Winsor patent No. 2,020,271 and Arndt patent No. 2,147,631 (R. 2-22). Each of said patents relates to a road grader.

The trial was without a jury, and judgment was rendered for respondent as to all patents (R. 62; 2222-6).

This petition only involves the Winsor patent No. 2,020,271, (R. 2298), consequently it alone will be discussed hereinafter in detail.

As to said Winsor patent No. 2,020,271 petitioners relied upon claims 2, **3**, 4, 5, 6, 7, 8, 9, **10**, 11, 13, 14, 15, 16, 19, 20, 21, 22, 23, 24, 26, 27, **28**, 29, 30 and **31** (R. 16) and alleged them to be infringed by respondent's Auto Patrols and Motor Graders (Pl's. Exh. 546; R. 1539 and 1541-3).

The District Court held the Winsor patent not infringed and while apparently considering it valid, rendered judgment for respondent (38 Fed. Supp. 783; R. 53-62; 2225-6).

On appeal from the judgment, the Court of Appeals for the Seventh Circuit, also held said patent not infringed and, in addition, held it invalid. 129 Fed. (2d) 70 (R. 3061).

A petition for rehearing was filed as to both the questions of validity and infringement of the Winsor patent as well as to two of the other patents involved, and it was denied (R. 3071).

II.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The decision of said Circuit Court of Appeals for the Seventh Circuit as to infringement is in conflict with its own decisions on the **same patent** in the case of *Galion* v. *Adams,* 105 F. (2d) 943 (First Suit) and the case of *Galion* v. *Adams,* 128 F. (2d) 411 (Second Suit); and its decision as to validity is in conflict with its own decision on the **same invention** (the Winsor patent had not then issued) in the case of *Myers et al.* v. *Austin-Western Road Machinery Co.,* 45 Fed. (2d) 751.

2. The decision of said Circuit Court of Appeals for the Seventh Circuit, as to infringement, by holding the Winsor patent infringed by, or as covering, the Adams graders in the case of *Galion* v. *Adams,* 105 Fed. (2d) 943 (First case), followed by its decision in the second case of *Galion* v. *Adams,* 128 Fed. (2d) 411 that the Adams and Caterpillar graders were of the same design and construction, together with its decision in the case on petition that said Winsor patent was not infringed by the Caterpillar graders, raises the question as to whether on the issue of infringement a patent is to be construed in one manner against a licensee (Adams) and in a different manner against one not a licensee (Caterpillar), which is an important question of federal law which has not been, but should be, settled by this Court.

3. The decision of said Circuit Court of Appeals for the Seventh Circuit as to both infringement and validity, by holding the Winsor patent not infringed and invalid, so far departs from the accepted and usual course of judicial proceedings, or so far sanctions such a departure by a lower court, as to call for an exercise of this Court's power of supervision.

4. The defendant, Caterpillar Tractor Co. is the only large manufacturer of road graders in the United States that is not a licensee under the Winsor patent, consequently there is little chance to receive any other decision on this patent in any other circuit, as a consequence of which a conflict in decisions of different Circuit Courts of Appeals is unlikely.

5. The decision of the Circuit Court of Appeals as to validity of the Winsor patent by holding it invalid as involving no invention over the Oswald 1919 machine and the Russell 1920 machine, involves an important question of federal law which has not been, but should be, settled by this Court; or said decision in this respect so far departs from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision. Said Court of Appeals treated each of the two mentioned devices as **prior inventions** and held Winsor's device, though admittedly quite different, did not **involve invention** over them. In fact, Winsor is a prior inventor as to said devices. They are only valid as 2 year statutory bars under Revised Statutes, section 4886 (U. S. C. title 35, Sec. 31), and as such should have been limited as forfeitures against Winsor of exactly what they disclosed. A prior invention may, under proper conditions, be reorganized in the light of common knowledge to show lack of invention in a later machine, but a dedication, abandonment, or statutory bar, as to which

one is a prior inventor, is not on the same basis under said Sec. 4886 but is limited in its effect to substantially exactly what it discloses.

Wherefore, your petitioners pray that a writ of certiorari issue under the seal of this Court, directed to the Circuit Court of Appeals for the Seventh Circuit, commanding said court to certify and send to this Court a full and complete transcript of the record and the proceedings of said Circuit Court of Appeals for the Seventh Circuit had in the case numbered and entitled on its docket, No. 7732, *Ronning Machinery Co. et al., Plaintiff-Appellant,* v. *Caterpillar Tractor Co., Defendant-Appellee,* to the end that this cause may be reviewed and determined by this Court as provided for by the statutes of the United States; and that the judgment herein of said Circuit Court of Appeals for the Seventh Circuit be reversed by the Court, and for such further relief as to this Court may seem proper.

Dated August 28, 1942.

RONNING MACHINERY CO., ET AL.,

By: HARKER H. HITTSON,
Counsel for Petitioner.